

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Schulze, *et al.*

Appl. No: 10/593,119

Filed: September 18, 2006

For: **Novel Alcohol Dehydrogenases**

Art Unit: 1633

Examiner: Maria Gomez Leavitt

Atty. Dkt.: 7601/88256

Conf. No: 5922

Response to Restriction Requirement

Commissioner of Patents
U.S. Patent and Trademark Office
Customer Service Window, MS Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Office Action dated January 29, 2009 in which the Examiner imposed a restriction requirement on the claims of the above-captioned application, Applicants hereby elect restriction group I. This includes claim 30 which, according to the Office Action received, is directed to “a polypeptide and homologous sequences that have the biological activity of an NAD- or NADP-dependent alcohol dehydrogenase.” In addition, Applicants elect the amino acid sequence of SEQ ID NO:34.

This election is made with traverse.

The Examiner argues that there is no special technical feature that links the claims of different restriction groups because the prior art has taught a novel alcohol dehydrogenase that is an efficient catalyst for a broad range of alcohols. However, this ignores the fact that there are sequences taught in the present application which may, when elected, be used to distinguish

polypeptides disclosed in the prior art. Applicants have elected a polypeptide having the sequence of SEQ ID NO:34 and submit that, in the absence of evidence to the contrary, this defines a unique polypeptide that serves as a special technical feature linking groups I, III and V. In other words, if the polypeptide is patentable, then a reaction system containing the polypeptide should also be patentable, regardless of what the other reaction components are. Similarly, a patentable polypeptide would render claims to a reaction that utilized the polypeptide (claims in group V) patentable. Applicants have submitted an amended set of claims herewith in which claim 30 has been limited to a polypeptide with the amino acid sequence of SEQ ID NO:34. Claims that appear as though they would be in restriction groups III or V have been included as "withdrawn" but Applicants are respectfully requesting that the separation of these claims into different groups be withdrawn and that all of the claims in the amendment undergo examination.

The USPTO has been electronically authorized to charge Applicants' credit card the fee for a two month extension of time for a large entity (believed to be \$490). The Director is hereby authorized to charge any fee deficiency, or credit any overpayment, to Applicants' Deposit Account No. 50-4056 under Order No. 7601/88256.

If, in the opinion of the Examiner, a phone call would help to expedite the prosecution of this application, the Examiner is invited to call Applicants' undersigned attorney at (240) 683-6165.

Respectfully submitted,
Law Office of Michael A. Sanzo, LLC

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Date: May 29, 2009
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